

REMARKS

Favorable reconsideration of this application is requested in view of the above amendments and following remarks. Claim 7 is amended and claim 20 is canceled without prejudice or disclaimer. Claims 4, 7, 10-12, 21-22, 29 and 30 are pending in the application. No new matter has been added. Reconsideration of the claims is respectfully requested.

In paragraph 4 on page 2 of the Official Action, Claims 4, 7, 10, 12, 20-22 and 29-30 were rejected under 35 USC § 103(a) as being unpatentable over Capps (US Publication 2002/0111813) in view of Lloyd-Jones (US Publication 2002/0055955), and further in view of Goldberg (US Publication 2004/0008872). In paragraph 20 on page 10 of the Official Action, Claim 11 was rejected under 35 USC § 103(a) as being unpatentable over Capps, Lloyd-Jones and Goldberg, in view of Davis et al. (US Publication 2002/0001395). Applicants respectfully traverse the rejections.

Capps fails to teach or suggest at least automatically forwarding said digital image from said first party to said electronic address of said second party over said communication network if said image content identifier matches a portion of said image. Applicants disagree with Examiner's assertion that Applicants' content identifier is obvious in light of Capps person-identifying (matching) functionality. Applicants submit that the person (content) that Capps is trying to identify does not have an associated electronic address of a second party. Rather, Capps' program module parses an electron document to identify a person, retrieves data relevant to the identified person, and notifies a user that the person has been identified. *See* [0050]. Capps further discloses that the retrieve data relevant to the identified person is then associated with hyperlinks. "For example, where the retrieved data represents a physical address, the . . . [hyperlink] may automatically provide directions to the location represented by the address." *See* [0066] and [0019]. Accordingly, Capps uses hyperlinks of the retrieved data from an identified person to perform specific actions relative to the retrieved data. The hyperlink is associated with the retrieved data not the alleged content identifier identified by the Office Action, and further, the hyperlink is not an electronic address of a second party for forwarding, automatically or otherwise, digital images from a first party to the electronic address of said second

party over a communication network if the image content identifier matches a portion of said image. A hyperlink is “[a] link from one part of a page on the Internet to another page A hyperlink is a way to connect two Internet resources via a simple word or phrase on which a user can click to start the connection.” NEWTON’S TELECOM DICTIONARY, 404 (20th ed. 2004).

Furthermore, Applicants invention analyzes a digital image media file at a first party for determining if a portion of the at least one digital image file matches an image content identifier, and automatically forwarding the at least one digital image. In sharp contrast, Capps device looks for data such as email addresses, name, or phone number and creates hyperlinks for this data.

Goldberg fails to remedy the deficiencies of Capps as Goldberg fails to teach or suggest at least automatically forwarding said digital image from said first party to said electronic address of said second party over said communication network if said image content identifier matches a portion of said image. Goldberg merely discloses that during an initial registration of a patron, an electronic image of the patron is stored in a database. [0107, 0142, 0144]. Subsequent to registration, captured images of the patrons are searched for in the database. The patron will then access these stored images at a distribution station. [0146]. Goldberg does not disclose image content identifier having an associated electronic address of a second party and forwarding, automatically or otherwise, digital images from a first party to the electronic address of said second party over a communication network if the image content identifier matches a portion of said image.

Lloyd-Jones fails to remedy the deficiencies of Capps and Goldberg as Lloyd-Jones fails to teach or suggest at least automatically forwarding said digital image from said first party to said electronic address of said second party over said communication network if said image content identifier matches a portion of said image. Rather, Lloyd-Jones discloses that a user can annotate an image by associating metadata with icons and then dragging and dropping the icon on an image. *See* Fig. 1, step 109 and [0029, 0030]. The metadata associated with the selected icon describes a person’s name and email address, and is stored in a list associated with the image file in a database along with the position where the icon was dropped within the image. *See* Fig. 1, step 113 and [0039]. There is nothing in Lloyd-Jones that discloses an image content

identifier having an associated electronic address of a second party and forwarding, automatically or otherwise, digital images from a first party to the electronic address of said second party over a communication network if the image content identifier matches a portion of said image.

Lloyd-Jones also discloses that if a user wishes, the user can subsequently search through the associated list(s) using the person's email address to gather image files and send these image files to another person. *See* [0039]. Accordingly, the address of the another person has no association to a content identifier which is required by Applicants' invention. Further, Applicants' invention requires the automatic forwarding of the digital image if the image content identifier matches a portion of said image. Lloyd-Jones is merely using the person's email address as a search term to search the associated lists and does not match anything to a portion of an image. Further, there is no associated electronic address of a second party associated with an image content identifier. Lloyd-Jones does not have an image content identifier, an image content identifier that is matched with portion of an image, nor an electronic address of a second party (associated with the image content identifier), and as such, could not automatically forward digital images from a first party to an electronic address of a second party. Further, it is noted that at least the matching step of Lloyd-Jones is not automatically performed, but user interaction is required.

Further, Lloyd-Jones discloses that if a "like to send" field in one or more lists are checked, then images in those lists can be sent to a subsequently selected user. *See* [0037] and [0039]. Similarly, as stated above, Lloyd-Jones merely searches through the associated lists and determines if the "like to send" field is checked, if so, the images are sent to a subsequently selected user. Digital images are not forwarded if an image content identifier matches a portion of an image as required by Applicants' claims.

It is submitted that further consideration of claim rejections under 35 USC 103(a) upon the citing of the fourth applied prior art reference to Davis is moot, inasmuch as the combination of Capps, Goldberg, Lloyd-Jones and Davis still lack any teaching, disclosure, or suggestion concerning a content identifier having an associated electronic address of a second party as previously discussed.

Therefore, in view of the above remarks, Applicant's claim 4 is patentable over the cited references. Rejected independent claims 7, 10, 12, 20-22

and 29 recite one or more features generally similar to those of claim 4 discussed above. Accordingly, for similar reasons as discussed above, independent claims 7, 10, 12, 20-22 and 29 are believed to be patentable over the cited references.

As an additional argument, Applicants respectfully contend that a *prima facie* case of obviousness has not been established, as described more fully below. To establish a *prima facie* case of obviousness, three basic criteria must be met:

- 1) There must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings;
 - 2) there must be a reasonable expectation of success; and
 - 3) the prior art reference (or references when combined) must teach or suggest all the claim limitations.
- (M.P.E.P. §2142).

Applicants respectfully submit that the cited references do not teach or suggest all the claim limitations as discussed above.

Further, there must be some actual *motivation* to combine the references found in the references themselves, the knowledge of one of ordinary skill in the art or from the nature of the problem to be solved that would suggest the combination. Without a suggestion of the desirability of “the combination,” a combination of such references is made in hindsight, and the “range of sources available, however, does not diminish the requirement for actual evidence.” *In re Dembiczak*, 50 USPQ2d 1614 (Fed. Cir. 1999). It is a requirement that actual evidence of a suggestion, teaching or motivation to combine prior art references be shown, and that this evidence be “clear and particular.” *Id.* Broad conclusory statements regarding the teaching of multiple references, standing alone, are not evidence. *Id.*

In view of the foregoing it is respectfully submitted that the claims in their present form are in condition for allowance and such action is respectfully requested.

Respectfully submitted,



Attorney for Applicant(s)
Registration No. 53,950

Thomas J. Strouse/phw
Rochester, NY 14650
Telephone: 585-588-2728
Facsimile: 585-477-4646

If the Examiner is unable to reach the Applicant(s) Attorney at the telephone number provided, the Examiner is requested to communicate with Eastman Kodak Company Patent Operations at (585) 477-4656.